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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,151	08/21/2001	Koichiro Kishima	SON-2198	6614
23353	7590	03/01/2004		
RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036				
			EXAMINER LESTER, EVELYN A	
			ART UNIT 2873	PAPER NUMBER

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/933,151

Applicant(s)

KISHIMA ET AL.

Examiner

Evelyn A. Lester

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 11-19 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 and 9 is/are allowed.
- 6) ☒ Claim(s) 1,2,6 and 20-22 is/are rejected.
- 7) ☒ Claim(s) 3-5,7,10 and 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election, without a proper traverse, of Group I (claims 1-10 and 20-23) in their response received on December 5, 2003 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 11-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the Applicant's response received on December 5, 2003.
3. The Applicant should note that rejoinder is a procedure set forth in the Official Gazette notice, dated March 26, 1996 (1184 O.G. 86), whether the election is made with or without traverse. Please note MPEP 821.04. Should the device or product claims be subsequently found allowable, the withdrawn process claims, which depend from or otherwise include all the limitations of the allowable device or product claims, will be rejoined.

### ***Claim Objections***

4. Claims 10 and 21 are objected to because of the following informalities:

With respect to claim 10, there is recited "a third groove" and "a fourth groove," which would imply that there should be a first and second groove. However, there are no recitations in the claim of a first and second groove. Since one of ordinary skill would at least wonder where the first and second grooves are, this makes the claim confusing. Since the "third groove" and the "fourth groove" are the only grooves claimed, it is suggested that they be renamed to be the first and second grooves.

With respect to claim 21, the "thereby" statement at lines 2-4, is a repeat recitation from claim 20, from which claim 21 depends. This is considered to be confusing, because it is unclear whether the thickness recitation of claim 20 or the thickness of claim 21 actually provides the function of the thereby statement. It is suggested to delete the thereby statement from claim 21.

Appropriate correction is required.

### ***Specification***

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2 and 6 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Nomura et al (U.S. patent 5,982,565).

Nomura et al discloses the claimed invention of an optical element having a "substrate" (i.e. the foundational material form) as noted in Figure 2 and its accompanying text, wherein there is a convex part (2) functioning as a convex lens, a flat part around the convex part (Figure 2), an outer circumference part (3) or flange, and wherein the thickness of the outer circumference part is greater than the convex part, therefore it is greater than the flat part and wherein the surface of the outer circumference part is flat or approximately flat (Figure 2).

With respect to the "whereby" statement at lines 7-8, while the features of an apparatus or product may be recited either structurally or functionally, claims directed to a product must be distinguished from the prior art in terms of structure rather than function.

7. Claim 1 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Iwaki et al (U.S. patent 6,219,191 B1).

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Iwaki et al disclose the claimed invention of an optical element having a "substrate" (2 and 3; i.e. the foundational material form) as noted in Figure 6 and its accompanying text, wherein there is a convex part (21 or 22) functioning as a convex lens, a flat part around the convex part (noted in Figure 6), an outer circumference part (outer edge of element 3) or flange, and wherein the thickness of the outer circumference part is greater than the flat part (Figure 6).

With respect to the "whereby" statement at lines 7-8, while the features of an apparatus or product may be recited either structurally or functionally, claims directed to a product must be distinguished from the prior art in terms of structure rather than function.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nomura et al (U.S. patent 5,982,565) in view of Lee et al (U.S. patent 5,665,957).

Nomura et al disclose the claimed invention of an optical element as described above, however, does not provide all the specific environment details, which this optical element is employed. Nomura et al do teach that the optical element is usable in optical

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recording systems and the like as noted in Figure 4 and its accompanying text, especially beginning at column 4, line 64, wherein Nomura et al describe the optical element mounted above a storage medium. However, Nomura et al are silent as to specifically reciting a photodetector. It is well known to one of ordinary skill in the art that such recording devices have photodetectors, as disclosed in Lee et al's invention. Since Lee et al clearly teach that providing a photodetector for an optical pickup or recording system is well known in the art for obtaining a focus error signal, for example, it would have been obvious to one of ordinary skill in the art that Nomura et al's employment of the optical element in an optical pickup system would have also included a photodetector to provide needed information relating to a focus error, for example.

***Allowable Subject Matter***

9. Claims 8 and 9 are allowable. Claim 10 will be allowable, once the required corrections are made.
10. Claims 3-5, 7 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
11. The following is a statement of reasons for the indication of allowable subject matter:

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The prior art fails to teach or fairly suggest the claimed subject matter of an optical element having the combination of claimed elements and claimed limitations, especially noting the recited claimed limitations directed to the grooves formed at the boundary of the convex part and/or between the flat part and the outer circumference part.

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn A. Lester whose telephone number is (571) 272-2332. The examiner can normally be reached on M- F, from about 10 am to 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Evelyn A. Lester  
Primary Examiner  
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